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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/690,349

10/21/2003

Jose B. Rivera

BCI-168US

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10/04/2006

RATNERPRESTIA

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VALLEY FORGE, PA 19482-0980

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,349

Applicant(s)

RIVERA ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/15/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 17-30 in the reply filed on August 11, 2006 is acknowledged.
2. Claims 1-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2006.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on January 15, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 17-26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al. (US 6,126,997 A).

A. This reference teaches all of applicant's claimed limitations except that the substrate is treated with *either* an organo-functional silane *or* a group IV-B element and a polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups [abstract; 5:1-40; and claim 11].

B. It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), which cites *In re Susi* 169 USPQ 423, 426 (CCPA 1971) and *In re Crockett*, 126 USPQ 186, 188 (CCPA 1960). See also *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992).

C. With specific respect to claims 18-20, it is the examiner's position that the ratio of silane to polymer blend is a result-effective variable, effecting various properties of the composition including viscosity, cross-linking density, etc. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Rivera so as to optimize this result-effective variable by routine experimentation, absent evidence of criticality. See MPEP § 2144.05.

7. **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., as applied to claim 17 above, and further in view of Petrole et al. (US 5,700,523 A).**

A. Rivera is cited herein again for the reasons detailed above.

B. This reference specifies magnesium substrates and does not explicitly disclose aluminum substrates.

C. Petrole teaches the treatment of aluminum substrates with a similar composition.

D. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Rivera so as to apply the composition to an aluminum substrate. One of ordinary skill would have been motivated to do so by the desire and expectation of successfully providing an adhesion-promoting, corrosion resistant coating on the aluminum substrate.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 17-26 and 28-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-15 of U.S. Patent No. 6,126,997 A.

A. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims fully encompass the subject matter of the co-pending claims except that, in the co-pending claims, the substrate is treated with *either* an organo-functional silane *or* a group IV-B element and a polymer blend having a plurality of carboxylic functional groups and a plurality of hydroxyl groups [abstract; 5:1-40; and claim 11].

B. It is *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), which cites *In re Susi* 169 USPQ 423, 426 (CCPA 1971) and *In re Crockett*, 126 USPQ 186, 188 (CCPA 1960). See also *Ex parte Quadranti*, 25 USPQ2d 1071 (BPAI 1992).

10. Claim 27 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Patent No. 6,126,997 A in view of Petrole et al. (US 5,700,523 A).

A. Although the conflicting claims are not identical, they are not patentably distinct from each other. The instant claims fully encompass the subject matter of the co-pending claims except that, the co-pending claim specifies magnesium substrates and does not explicitly disclose aluminum substrates.

B. Petrole teaches the treatment of aluminum substrates with a similar composition.

C. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Rivera so as to apply the composition to an aluminum substrate. One of ordinary skill would have been motivated to do so by the desire and expectation of successfully providing an adhesion-promoting, corrosion resistant coating on the aluminum substrate.

Conclusion

11. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

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272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III
Patent Examiner (FSA), USPTO
Art Unit 1762

Fredericksburg, VA
September 29, 2006